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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Sontheimer <i>et al.</i>	Examiner:	Chen, Shin Lin
Patent No:	7,678,759	Group Art Unit:	1632
Issue Date:	May 16, 2010	Confirmation No.:	7705
Serial No.:	10/686,782		
Filing Date:	October 17, 2003		
Title:	DIAGNOSIS AND TREATMENT OF NEUROECTODERMAL TUMORS		

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Mail Stop Office of Petitions
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

**APPEAL TO DECISION DISMISSING REQUEST FOR RECONSIDERATION
OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705 (d)**

Applicant hereby appeals the decision of the Office of Petitions (in re Patent No. 7,678,759, mailed on December 6, 2010) dismissing the Petition for a Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. § 1.705 (d) (filed on October 14, 2010). The Decision set forth a deadline of two (2) months from the mailing date, *i.e.*, on February 6, 2011, to respond (which falls on a Sunday, thereby extending the due date to the next business day). Applicants therefore submit that the present Response is timely.

The Office of Petitions (the "Office") and the Applicant disagree with respect to the calculation of the number of days of B delay and how relevant C delay is determined when a Notice of Appeal was filed. Applicant respectfully maintains disagreement with

the Office's calculation of the B delay.

Wyeth v. Kappos (No. 2009-1120) clarified the PTA statute set forth in 35 U.S.C. § 154(b). Briefly, "A" delay accrues when the PTO fails to act in accordance with set timeframes (such as issuing a first office action within 14 months, issuing a second action or allowance within 4 months of a response, and issuing a patent within 4 months of the Issue Fee payment). "B" delay accrues when the PTO fails to issue a patent within three years of the actual filing date of the patent application. And "C" delay accrues when the application is involved in an interference or appeal, or is subject to a secrecy order.

Applicant reasserts the arguments set forth in the Petition filed on October 14, 2010, and further provides the following remarks to support the position.

As provided in detail in the previous Petition, in the instant case, the initial three year term ended on October 17, 2006 (3 years after the actual filing date) for purposes of determining "B" delay. Thereafter, until an RCE was filed on October 31, 2007, which "reset" the clock for a second three year term, there is a period of **378 days** which corresponds to "B" delay, as indicated in the Decision.

At issue is whether filing of a Notice of Appeal (May 25, 2007) precludes B delays from accruing, under subsection (C).

The section of the statute that provides PTA for B delay (also referred to as "3 year" delay) includes three exceptions. Section 154(b)(1)(B)(ii) excludes:

*any time consumed by a [interference] proceeding under section 135(a), any time consumed by the imposition of a [secrecy] order under section 181, or **any time consumed by appellate review by the Board of Patent Appeals or Interferences of by a Federal Court.***

As noted above, however, PTA for C delay can accrue for the delays that are excluded from B delay. With regard to delays due to an appeal, PTA only accrues in cases where "the patent was issued under a decision in the review reversing an adverse determination of patentability." If an Applicant appeals a rejection and wins at the Board, B delay will not accrue while the application was on appeal, but C delay will.

In the instant case, Applicant filed a Notice of Appeal on May 25, 2007, but it never got to the Board. Instead, an Advisory Action was mailed on June 27, 2007, and subsequently, an RCE was filed on October 31, 2007. Thus, here, prosecution extended into the B delay period (more than 3 years after the filing date) and a Notice of Appeal was required to keep the application pending after a response to a final Office Action.

As provided above, the statute expressly excludes only “*time consumed by appellate review by the Board*,” but these applications never reached the Board. Indeed, an Appeal Brief was never filed in this case. Therefore, the Appeal Board did not consume time on review. The USPTO’s own rule, 37 CFR § 41.35, provides that jurisdiction does not pass to the Board until *after* all briefs and the examiner’s answer have been entered. Thus, mere filing of a Notice of Appeal does not stall the delay period for purposes of calculating B delay under § 154(b)(1).

Accordingly, Applicant respectfully submits that PTA for this time based on the B delay exclusion in 35 USC § 154(b)(1)(B)(ii) should be awarded.

Based on the foregoing, the proper calculation of the B delay is at least 358 days. Therefore, Applicants should be entitled to a patent term adjustment of 617 days (468 days of A delay plus 378 days of B delay minus 209 days of applicant delay). Appropriate correction to the patent term adjustment indicated on the face of the above-referenced patent is respectfully requested.

Applicants believe that no fees are due with this response. In the event that any fees are believed due, a Notice to that effect is respectfully requested. If, for any reason, this Response is found to be non-compliant or otherwise improper, please contact the undersigned agent by telephone at 1 (617) 248-4019.

Respectfully submitted,

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